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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,386	08/01/2001	Greg Eippert	27228/04002	4401

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 05/04/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/920,386

Applicant(s)

EIPPERT, GREG

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Applicant request reconsideration of the previously amended claims. Applicant has amended the drawings to overcome the previous drawing objections.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7-10 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whaley (5,995,938) in view of Mayfield (5,261,702).

Whaley discloses a system of reminding a patient comprising a sheet (156) depicting one or more rows (158) and columns (160, 162, 164, 166, 168, 170) to form a matrix comprising a plurality of fields (boxes on the chart); wherein the row and columns further include headers ("MORNING", "NOON", ..etc) defining parameters; wherein the headers include medical markings (textual notes) which include indicators of medication ("MEDICINES"), and icons (in Fig. 7 and 11), and indicia markings (172, 174, 176, 178) disposed outside of the matrix; and one or more color coded stickered (94, shown in Fig. 4) medication (prescription) containers (not shown, but stated in Col. 5, lines 32-39, wherein the sticker (94) can be placed on any part of the container housing, which includes the cap). Whaley further discloses in Fig. 7 and 11, a reminder system comprising medical markings (138, 142, 150) representing a time period within a day.

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However, Whaley does not disclose: wherein one or more rows are color shaded with different colors; medications related to ophthalmology; markings designate which eye to place medication within.

Mayfield discloses in Fig. 2, a reminding system comprising rows (A) and columns (B), wherein rows and columns are filled in (not entirely) by filling in individual cells with colors as necessary Col. 7, lines 6-8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Whaley's system to include designating a field within each row for color identification using a various colors as taught by Mayfield for the purpose of color coding the matrix.

In regards to **Claims 4**, a recitation of the intended use of the claimed invention (medications which relate to opthamology; and markings which designate which eye to place medication within) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the reminding system of Mayfield as modified by Whaley is capable of having medications which relate to opthamology.

In regards to **Claim 5**, the method in which the medical markings designate which eye to place the medication within does not structurally limit the claim. The patentability of a product

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does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to incorporate medical markings which designate the use of medications..

3. Claims 6, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whaley in view of Mayfield, and further in view of North et al (5,992,888).

Whaley as modified by Mayfield discloses a reminder system comprising all the elements as claimed in Claims 1 and 3, and as set forth above.

However, Whaley as modified by Mayfield does not disclose: advertising markings and coupons which correspond to one of the medication indicators; and a plurality of areas for placing advertising markings.

North et al discloses in Fig. 1-4 and 9, a reminder system comprising advertising markings (11) placed in an area, and coupons (16).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Whaley's reminder system to include advertising markings and coupons in place of the indicia markings as taught by North et al for the purpose of providing an advertising method which focuses specific advertising material to a preselected market segment, which may be used by the end user.

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In regards to **Claims 6, 16 and 19**, in which the advertising markings correspond to one of the medication indicators, or a pharmacy, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the advertising markings and coupons of North et al are capable of corresponding to medication indicators and to a pharmacy depending on the indicia printed in the advertising area and on the coupons.

In regards to **Claims 18 and 19**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many areas as desired to place advertising markings, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to include as many areas as desired, since applicant has not disclosed the criticality of having a plurality of areas for placing advertising marking, and invention would function equally as well with any number of areas and would serve the end user by giving holding information related to the reminder system.

4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whaley in view of Mayfield and further in view of Cutting (4,295,664).

Whaley discloses a system of reminding a patient comprising a sheet (156) depicting one or more rows (158) and columns (160, 162, 164, 166, 168, 170) to form a matrix comprising a plurality of fields (boxes on the chart); wherein the row and columns further include headers

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("MORNING", "NOON", ..etc) defining parameters; wherein the headers include medical markings (textual notes) which include indicators of medication ("MEDICINES"), and icons (in Fig. 7 and 11), and indicia markings (172, 174, 176, 178) disposed outside of the matrix; and one or more color coded medication (prescription) containers (not shown, but stated in Col. 5, lines 32-39). Whaley further discloses in Col. 9, lines 64-67 that the chart can be multiple pages depending on the number of medications.

However, Whaley does not disclose: wherein one or more rows are color shaded with different colors; and tablet of multiple sheets of paper.

Mayfield discloses in Fig. 2, a reminding system comprising rows (A) and columns (B), wherein rows and columns are filled in (not entirely) by filling in individual cells with colors as necessary Col. 7, lines 6-8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Whaley's system to include designating a field within each row for color identification using a various colors as taught by Mayfield for the purpose of color coding the matrix.

However, Whaley as modified by Mayfield does not disclose a tablet of multiple sheets of paper.

Cutting discloses in Fig. 1-4, a system reminder comprising a tablet of multiple sheets.



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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Whaley's and Mayfield's system to include a tablet of multiple sheets as taught by Cutting for the purpose of keeping track of multiple records of information.

***Response to Arguments***

5. Applicant's arguments filed on July 17, 2003 have been fully considered but they are not persuasive.

In regards to applicant's argument that applicant's invention does not disclose providing color shaded rows of a matrix, which consists of color shaded rows on a color coded sheet, the examiner submits again that the prior art (Mayfield) does indeed disclose wherein rows and columns are filled in (not entirely) with colors in individual cells, which as a result forms the color coded sheet. Applicant must note that the claims do not disclose that the entire row or column had to be completely filled or shaded in. Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *color shaded rows on a color coded sheet* ) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

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In regards to applicant's argument that there is no suggestion to combine the references of Whaley and Mayfield with North, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Whaley as modified by Mayfield discloses a reminder system comprising a color coded sheet having rows and columns, headers, medical markings and color coded medication containers. However Whaley and Mayfield do not disclose a reminder system having: advertising markings which correspond to medication indicators. North et al is cited for only disclosing a reminder system (wherein the end user is reminded of transaction through record keeping) having advertising markings and coupons. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Whaley's reminder system to include advertising markings and coupons in place of the indicia markings as taught by North et al for the purpose of providing an advertising method which focuses specific advertising material to a preselected market segment, which may be used by the end user. Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the

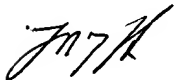
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intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Therefore, the North et al reminder system although not used for medical purposes is capable of performing the intended use of Whaley and Mayfield. Furthermore, since applicant discloses broad limitations of what a system reminder entails, the examiner has interpreted a "reminder system" in its broadest sense.

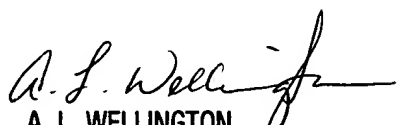
#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

April 30, 2004



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